

REMARKS

This Response is submitted in response to an outstanding Final Office Action dated March 4, 2009 (the “Office Action”). The shortened statutory period for response expired on June 4, 2009. Therefore, this Response is submitted with a Petition for Extension of Time and the necessary extension fees. In addition, Applicant submits a Notice of Appeal with the appropriate fee.

I. Status of the Claims

Claims 21-24, 26-29, 31-34, and 36-37 are now pending in the application with claims 21, 26, and 31 in independent form. Applicant previously canceled claims 1-20, 25, 30, and 35, hereby amends claims 21, 26, and 31, and adds new claims 36-37.

II. Rejections under 35 U.S.C. § 103

In the Office Action, Examiner rejected claims 21-24 and 26-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. Pub. No. 2002/0161603 A1 to Gonzales (“Gonzales”), and further in view of U.S. Pat. No. 6,126,202 A to Scocca (“Scocca”), U.S. Pat. No. 6,210,172 B2 to Clements (“Clements”), and U.S. Pat. No. 5,127,879 A to Schubert (“Schubert”). In addition, the Examiner rejected claim 31-34 as being unpatentable over Gonzales, Scocca, Clements, Schubert, and U.S. Pat. No. 5,397,156 A to Schach et al. (“Schach”). Applicant respectfully traverses Examiner’s rejections.

“The examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., *the reference teachings* establish a prima facie case of obviousness) is more probable than not.” (Emphasis added).

“Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows: (A) Ascertaining the” scope and content of “the prior art; [] (B) Ascertaining the differences between the claimed invention and the prior art; and (C) Resolving the level of ordinary skill in the pertinent art.” MPEP 2141; *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 399 (U.S. 2009). In order for the Examiner to make a *prima facie* showing of obviousness, the Examiner must analyze the prior art references and the differences between the claimed invention and the prior art.

Although the Examiner states that “one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references,” Applicant respectfully notes that the Examiner’s entire analysis is based on explaining what reference A purportedly shows, what reference A is lacking, what reference B purportedly shows, and how reference B purportedly provides what reference A is lacking, etc. As an entire section of Applicant’s Response C to Non-final Office Action is dedicated to a discussion of all the five cited references together and, in addition, there is an entire section traversing the combination under *KSR*, Applicant respectfully asserts that Applicant did not merely attack each reference individually. Moreover, the discussion of the references were meant to enlighten the Examiner as to why the Examiner’s analysis in determining the scope and content of the prior art is incorrect. In other words, Applicant is reading each reference for “*what it fairly teaches* in combination with the prior art as a whole” to ensure that each reference indeed discloses what the Examiner asserts that it is disclosing. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Applicant respectfully explains that one of ordinary skill in the art at the time the invention was made would not have been able to make a combination of Gonzales, Scocca,

Clements, Schubert, and Schach to develop the claimed subject matter nor would one of ordinary skill had reason to do so. First, the combination of all the cited references would have such differences between the prior art and the claimed invention, that one of ordinary skill in the art would **not** have found it obvious. Second, one of ordinary skill in the art at the time the invention was made would have **no** reason to combine the five references to make the claimed subject matter without applying impermissible hindsight.

A. Combination of Gonzales, Scocca, Clements, Schubert, and Schach Does Not Disclose Nonobvious Elements of the Claimed Invention

In addition to the more detailed discussion below, Applicant respectfully asserts that the all references cited by the Examiner at least do not disclose

automatically generating by the computer a cover page for printing on a first leaf's front-side from the ***first set of inputs***, wherein the cover page includes at least one of title information, author information, and one or more images; ...

automatically generating by the computer a title page for printing on the first leaf's back-side and a second leaf's front-side, wherein the title page includes the title and author information and a copyright notice information; ...

automatically generating by the computer a first story page from the one or more images ***from the second set of inputs*** for printing on the second leaf's back-side and automatically proportionally enlarging the one or more images from the second set of inputs on the first story page to a maximum size that does not overlap margins of the first story page; [and/or] ...

automatically generating by the computer a second story page from the one or more images and the corresponding text from the second set of inputs for printing on a third leaf's front-side, wherein the one or more images and corresponding text from the second set of inputs, when printed, appear oriented in diametric contraposition to the one or more images on the first story page....

as stated in currently amended independent claims 21, 26, and 31. In addition, Applicant asserts that the cited references would not teach one of ordinary skill in the art these limitations. In particular, the combination of cited references operate in a "what you see is what you get"

(“WYSIWYG”) manner. That is, what the user sees and inputs, is what the software outputs on a page-edit-by-page-edit basis. On the contrary, in aspects of the present disclosure, the user inputs minimal information in two “*blank story book screens*” which results in “*automatically generating*” at least “a cover page,” “a title page” (that is printed on a first leaf’s back-side and a second leaf’s front-side), “a first story page,” and “a second story page” “*for printing in diametric contraposition*”. In addition, the data that the user inputs is presented in different ways depending on the page (e.g., some pages have just the image proportionally enlarged, while other pages have the image and certain text). The Examiner has presented no evidence as to why one of ordinary skill in the art at the time of the invention would have significantly modified the combination of Gonzales, Scocca, Clements, Schubert, and Schach to anything other than a WYSIWYG-type invention. Accordingly, these references alone, or in combination, do not disclose or teach the limitations stated in independent claims 21, 26, and 31 and/or the claims that depend therefrom.

1. Gonzales

In the Office Action, the Examiner states that “In regards to Applicant’s remarks that Gonzales teaches only publishing software, and fails to teach where the generated book is a story book, the Examiner notes that Gonzales is not relied upon to teach the limitation.” Applicant respectfully submits that Applicant has not suggested that Gonzales teaches generation of a book. In fact, Applicant has consistently maintained that Gonzales fails to disclose the generation of a book, and further does not disclose or suggest book publishing. Rather, Gonzales at para. 0023 discloses: “Although the system may be employed for publishing hard copy material, such as a brochure or magazine, it is described herein in the context of a web site, where the term ‘publish’ means to post material to the site, i.e., to ‘go-live’ on the site.”

On the contrary, Applicant respectfully responded to the Examiner's statements that "Gonzales teaches a *storytelling book* and method providing a *storytelling book*"; and "Gonzales teaches a system and method for producing a *storytelling book*, comprising a software program in a computer." (Emphasis added). The Examiner notes that "What Gonzales fails to teach is where the published book is a story book...." Applicant respectfully asserts that Gonzales teaches web page publishing software and fails to teach generating a storytelling book (Gonzales, paras. 0046-0058, and Figs 4-15). Applicant respectfully maintains that while Gonzales teaches web publication and includes a print module, Gonzales does not teach the publication of a book (Gonzales, para. 0023). Moreover, Applicant respectfully submits that the Examiner has referred to the "*web publishing* system such as Gonzales...." (Emphasis added).

Applicant's remarks regarding Gonzales failing to teach the producing of a storytelling book are intended to emphasize that Gonzales is non-analogous art, and that it would be improper to combine the non-analogous art of web publishing software with the other prior art of Scocca, Clements '172, Schubert and Schach in an obviousness analysis. *See* MPEP 2141.01(a).

In the Office Action, the Examiner stated that "Gonzales teaches a storytelling book and method of providing a storytelling book (interactive publishing system, Para. 0032; method, Para. 0043-44)." Office Action at p.2, para. 4. Gonzales Para. 0032 discloses: "The present invention relates to an interactive publishing system capable of supporting multiple lines of business (LOBs). Although the system may be employed for the publishing of hard copy material, such as a brochure or magazine, it is described herein in the context of a web site, where the term 'publish' means to post material to the site, i.e., to 'go-live' on the site." Gonzales Para. 0043 discloses: "Memory 135 holds data and instructions for execution by

processor 130. In particular, memory 135 contains a program module that controls processor 130 to perform a method in accordance with the present invention as described herein. The program module is also known as a content management application.” Gonzales Para. 0044 discloses:

Although system 100 is described herein as having the instructions for the method of the present invention installed into memory 135, the instructions can reside on an external storage media 140 for subsequent loading into memory 135. Storage media 140 can be any conventional storage media, including, but not limited to, a floppy disk, a compact disk, a magnetic tape, a read only memory, or an optical storage media. Storage media 140 could also be a random access memory, or other type of electronic storage, located on a remote storage system and coupled to memory 140.

Accordingly, Gonzales merely discloses *a* system and *a* method for publishing, but in no way teaches or discloses “a *storytelling book* and method of providing *a storytelling book*,” as described in independent claims 21 and 26.

In the Office Action, the Examiner stated Gonzales teaches “(a) accepting a first set of inputs from a user in a first graphical user interface screen and providing them to the software program (an Author can create an article, etc., Para. 0068-78).” Office Action at p.2-3, para. 4. Gonzales paras. 0068-78, in short, discloses:

An Author can create an article, add content to the article, edit the article and delete the article.... [T]he Author can establish or define new content, edit the content and delete the content....The Author can create a new article. A new article is a page, such as a web page, of information about a topic. The Author can edit an article that is returned to the Author by an Editor.

Applicant has previously amended claims 21 and 26 to read “first blank story book screen”, and thus Examiner’s reference to “first graphical user interface screen” are no longer germane to patentability. Applicant respectfully submits that Gonzales does not disclose any *blank story book screens*, but rather discloses a general web page publishing software (Gonzales, paras. 0046-0058, and Figs 4-15). In Gonzales, what the user sees and inputs, is what the software

outputs (i.e., WYSIWYG); therefore, Gonzales fails to disclose any use of blank story book screens in any respect, including as stated in independent claims 21, 26, and 31.

In the Office Action, the Examiner stated Gonzales teaches

“automatically generating, using said software program, a title page for printing on the first leaf’s back-side and a second leaf’s front-side, a first story page from the one or more ... images from the second set of inputs and a secondary story page from the second set of inputs including the one or more ... images and the corresponding text for printing on a third leaf’s front-side (Click a submit button to view the edited article. At this point the article is laid out in accordance with the template that the Author used to create the article, Para. 0209) for printing on the second leaf’s back-side”.

Office Action at p.3, para. 5. In aspects of the present disclosure, “the second set of inputs” effects automatic generation (i.e., in the step of “*automatically generating*”) of “a first story page, ... and a second story page”. In addition, the “first story page” is automatically generated “for printing on the second leaf’s back-side”; and the “second story page” is automatically generated “for printing on a third leaf’s front-side”. The templates in Gonzales cited by the Examiner refer to Figure 5, which “shows a set of several exemplary layout templates” (Para. 0019). Figure 5 of Gonzales illustrates six templates for web page publication of articles. Applicant respectfully submits that none of the templates teach to generate a “first story page” for “printing on the second leaf’s back-side”, and a “second story page” for “printing on the third leaf’s front side” as disclosed in the present invention. Furthermore, Gonzales neither teaches nor contemplates automatically generating story pages for printing wherein the “one or more images from the second set of inputs” is used to automatically generate *both* a “first story page” and a “second story page”. Lastly, Gonzales teaches no such step of automatic generation; instead, Gonzales teaches that what the user inputs/sees is what the software outputs (i.e., what the user gets). Therefore, Gonzales does not disclose the above mentioned steps of “*automatically generating*” of story pages as stated in independent claims 21, 26, and 31.

In the Office Action, the Examiner stated that Gonzales teaches “wherein said one or more indicia include graphical symbols (image assets, Para. 0051; understood to be graphics)”. Office Action at p.8, para. 10. Gonzales para. 0051 discloses

A content component of an article can be any of text, a link (text based or image based), or an asset (e.g., image, sound, video, animation). An element of a template is a defined space within which a content component is rendered, i.e., positioned and displayed, or in the case of an active content component such as an audio clip, executed. A template may include a plurality of elements.

Applicant respectfully submits that Gonzales does not disclose using “*indicia*” “for indicating how to assemble ... in diametric contraposition,” as stated in independent claims 21, 26, 31.

Since Gonzales is WYSIWYG publishing software, it does not disclose “*automatically generating* one or more *indicia*” on pre-set pages for use “indicating how to *assemble ...in diametric contraposition*” as taught in the present invention. Although Gonzales discloses the general use of “an asset (e.g., image”) in creating web page content (Gonzales, para 0051), it does not disclose using “graphical symbols” as “indicia” in the manner described above and as claimed. As a result, Gonzales does not disclose “said one or more indicia include graphical symbols,” as described in dependent claims 24, 29, and 34.

In the Office Action, the Examiner states that

In response to Applicant’s argument that Gonzales does not disclose “the first set of inputs,” because an “article name or page name” is not “author information”; an “article title” – in the web page context – is the <TITLE> tag in HTML, which relates to the title of the specific page (or “article”), not the title of the entire work; in the web-page context or any other, a string of text comprising author, title, or copyright information, etc. is merely non-functional printed matter, and having no tie in function to the substrate, is not patentably distinguishable over the prior art ...[as] USPTO personnel need not give printable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate.

Applicant respectfully asserts that the “first set of inputs” the computer accepts operate as functional descriptive material because the inputs allow the computer to automatically

generate multiple pages from a minimum amount of input that are necessary to achieve the result of one aspect of the invention, which includes, *inter alia*, the cover and title pages. *Even if* the Examiner interprets the first set of inputs to be “nonfunctional descriptive matter,” Applicant respectfully asserts that other claimed aspects of the present invention, as argued in this Response, constitute sufficient nonobvious subject matter for the pending claims to be patentable.

For all the reasons above, Applicant respectfully asserts that Gonzales does not teach or disclose the above mentioned limitations of at least currently amended independent claims 21, 26, and 31 and the claims that depend therefrom.

2. Scocca

First, in the Office Action, the Examiner stated Scocca teaches “wherein the title page, and first and second story pages include one or more indicia for indicating how to assemble the second story page”. Office Action at p.5, para. 5. In particular, “instructional indicia for indicating how to assemble the book (FIG. 1 is an illustration of the instruction sheet in which the contents of the invention the book publishing kit is listed....)”. Office Action at p.4, para. 4. “The templates taught by Gonzales would also be adapted to provide a page bearing publishing instructions, such as is taught by Scocca”. Office Action at p.5, para. 5. In addition, the Examiner stated Scocca teaches “instructional indicia for indicating how to assemble the book (2:13-31)”. Office Action at p.7, para. 8.

As shown in Scocca FIG. 1, Scocca merely discloses a separate “instructional sheet” (Scocca, 2:13-15). Or, respectfully, as Examiner states, Scocca provides “*a page* bearing publishing instructions.” Office Action at p.5, para. 5 (emphasis added). In other words, Scocca does not teach or disclose “one or more *indicia* for indicating how to assemble the second story

page....” And, in Scocca, where there are instructions, and *not indicia*, those instructions are not included on each of the “title page, and first and second story pages”. Applicant respectfully submits that in contrast, aspects of the present invention include printing “indicia” on the substantive title and first and second story pages for showing the user how to assemble the story pages in a book.

Second, the Examiner stated in Office Action at pp. 7-8, para. 9 that “Scocca teaches where page indicium includes numbering (Figure 6, Item 49).” With respect, Scocca merely shows page numbering in Figure 6, Item 49, and not “one or more *indicia* for *indicating how to assemble* the second story page ... wherein said one or more indicia include page numbers” as presently claimed. In other words, Scocca does not teach to use page numbers to indicate how to assemble the book, and in particular, Scocca does not teach assembly of “the second story page in diametric contraposition to the first story page.”

Third, in the Office Action, the Examiner began by stating that Scocca taught a page of instructions (Office Action at pp. 4-5, para. 5). Then, in the Office Action at p. 7, para. 9, the Examiner compared the “wherein said one or more indicia include page numbers” with page numbers disclosed in Scocca Fig. 6, Item 49, and 2:13-15. Applicant respectfully submits that use of the word “said” refers to an antecedent use the phrase “one or more indicia”. Thus, with this well understood use of “said”, the Examiner must be implying that the instruction page taught in Scocca “include” page numbers. However, Scocca teaches no such limitation. Indeed, page numbers disclosed at Scocca Fig. 6, Item 49 and 2:13-15 do not pertain or relate to the instruction page in any manner. As a result, Scocca does not teach “one or more indicia for indicating how to assemble ... wherein said one or more indicia include page numbers” as presently claimed at Claim 33.

For all the reasons above, Applicant respectfully asserts that Scocca does not teach or disclose the above mentioned limitations of at least currently amended independent claims 21, 26, and 31 and the claims that depend therefrom.

3. Clements

First, in the Office Action, the Examiner stated that in Clements the “page arrangement is understood to be ‘in diametric contraposition’.” Office Action at p. 6, para. 6. As such, the Examiner contended that Clements teaches

automatically generating a second story page from the second set of inputs for printing on a third leaf’s front-side including the one or more images and the corresponding text, wherein the one or more images and corresponding text, when printed, appear oriented in diametric contraposition to the one or more images on the first story page,

as stated in independent claims 21, 26, and 31. However, Clements discloses WYSIWYG by providing insertion pages for the user to insert drawings or text (i.e., each insertion page requires drawing(s) or text to be added). Accordingly, Clements does not teach “*automatically generating*” any story pages from “inputs from a user”.

Second, in the Office Action, the Examiner responds to “Applicant’s arguments further directed to Clements ’172” as “not persuasive” because “[t]he courts have held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.” Office Action at p. 10, para. 18. Applicant respectfully asserts that aspects of the present invention are not mere automations of Clements ’172. Aspects of Clements ’172 disclose using blank insertion pages, and a WYSIWYG mode of operation (Clements ’172 at 5:66–6:26). The insertion pages (which contain the pictures and text, Clements ’172 at 6:11-36) are held in place by page holders (Clements ’172 at 5:67–6:9, and 6:54–58). In contrast, aspects of the present invention, *inter*

alia, do not require the use of insertion pages or page holder as taught by Clements '172.

Aspects of the present invention allow the user to input data that then automatically generates multiple pages from the user input for assembly in diametric contraposition.

Furthermore, Clements '172 teaches away from the present invention. Clements '172 at 6:24-26 discloses that “[t]he insertion pages are preferably *one-sided* for use with clear loose-leaf holders having a stiff opaque insert.” In contrast, independent claims 21, 26 and 31 all teach printing on both sides of a leaf; in particular, a cover page is automatically generated for printing on the “*first leaf’s front* side,” a title page is automatically generated for printing on the “*first leaf’s back-side* and a *second leaf’s front-side*,” a first story page is automatically generated for printing on the “*second leaf’s back* side,” and a second story page is automatically generated for printing on a “*third leaf’s front* side”.

Moreover, the result in Clements '172 is different from the present invention as Clements '172 uses clear loose-leaf page holders. Thus, with the teaching away and the different result, Applicant respectfully submits that the present invention is not merely “providing an automatic or mechanical means to replace a manual activity which accomplished the same result.”

Third, in Response to Arguments in Office Action p. 10, paras. 16 and 17, the Examiner stated that “Clements '172 teaches providing instructions for assembling the book pages in diametric contraposition as indicia in the story book,” and in support, the Examiner cited Clements '172 at 6:24-48, which in short states

... [the] insertion page has two columns of dotted lines with the *instructions* "*Write your story using these lines*" noted in parentheses at the top of the page. On this lined corresponding insertion page, a space without lines is provided in the lower right-hand corner with the *instructions*, "*Paste a reduced size copy of your picture here*" noted in the space. (emphasis added)

Applicant respectfully submits that Clements '172 does not teach using *indicia* for *assembly* of a storytelling book. The instructions of "Write your story using these lines" and "Paste a reduced size copy of your picture here" are directed towards providing content for the insertion pages in Clements '172, and not directed towards assembly of the book. In contrast, the present invention claims "*indicia* indicating how to *assemble* the second story page in diametric contraposition to the first story page."

For the reasons above, Applicant respectfully asserts that Clements does not teach or disclose the above mentioned limitations of at least currently amended independent claims 21, 26, and 31 and the claims that depend therefrom.

4. Schach

First, the Examiner stated that Schach teaches "a front cover that houses the printed cover page and binds with the printed title page, the first story page, the second story page, and a back cover" and cites Schach, 3:12-31, 4:33-48, and Figures 1 and 2 for his conclusion. Office Action at p.8, para 12. Schach at 3:12-31 reads

An exemplary kit according to the present invention is shown generally by reference numeral 10 in FIGS. 1 through 3. The kit includes a simulated book, shown generally by reference numeral 12 in FIG. 6, which typically comprises a book cover 13, and one or more pieces (thicknesses) of foam core 14, or like material (preferably white in color and simulating what the pages of a book look like from the exterior, e.g. styrofoam laminated to paper board) which is adapted to be received within the cover 13. If desired the cover 13 and foam core 14 can be secured together, as by a strip of adhesive 15 extending along one edge of the inside surface 16 of the book cover 13, which engages a similar edge of one face of the foam core 14, or by spray adhesive 15' covering the entire inner face of the cover, or double index tape. The simulated book preferably has substantially the same size and shape as a real paperback novel, i.e. roughly about 4.x.7 inches, and about 1/8-3/4 inch thick.

And Schach at 4:33-48 reads

The kit 10 may also include other sheets of paper, such as a separate sheet of detailed printed instructions, sales literature for other or related products, guarantees, or the like. For example, one particularly worthwhile insert would be a folded sheet of paper with detachable order form (to fit in reply envelope 19) which describes and allows one to order options which enhance the "basic" book. For example, for additional sums (submitted with the reply envelope and questionnaire, e.g. by check or credit card charge authorization) one could order a personal message in the book, a custom page, or by submitting one's own photo have a custom cover or photo page made (with the submitted photo on it), including a custom cover with an "oil painting" version of the submitted photo (produced by computer photo-enhancement technology).

Applicant respectfully submits that nothing in the above quotes nor in the remainder of Schach teach that the front cover "houses the printed cover page". Nothing in the above quotes nor in the remainder of Schach teach that the front cover "binds with the printed title page." Figure 1 of Schach merely discloses the cover of the kit and the cover includes "Book Title". However, Schach does not teach a "printed cover page" and a "printed title page" (Schach, Figure 1, reference numerals 36 and 34; also see 4:49-58).

Second, the instructions taught in Schach are for using the kit for producing a personalized romance novel using a mail-in to the manufacturer method (Schach, 1:38-46, 2:22-39). Thus, Schach does not teach indicia as understood in aspects of the present invention: indicia "indicating how to *assemble*... wherein the second story page is oriented in diametric contraposition to the first story page."

For the reasons above, Applicant respectfully asserts that Schach does not teach or disclose the above mentioned limitations of at least currently amended independent claim 31 and the claims that depend therefrom.

B. Reasoning to Combine under KSR

As stated in MPEP § 2141:

The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made *explicit*. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness *cannot* be sustained by *mere conclusory statements*; instead, there must be some articulated *reasoning* with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

(emphasis added).

Although Applicant respectfully asserts that the Examiner has not met his burden of identifying the claimed elements in the prior art (as traversed above), Applicant also submits that the Examiner has not provided adequate reasons to combine the cited references.

First, for combining Scocca to Gonzales, the Examiner stated "it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have adapted the publishing templates of Gonzales to include" various aspects of the present invention "in order to assist an amateur author in publishing a professional-looking story book" and "*to allow an amateur publisher to print and bind 'proof' or 'draft' copies of the storybook themselves, without requiring outside assistance or additional postage.*" Office Action at pp. 5-6, para. 5 (emphasis added).

For combining Clements with Scocca and Gonzales, the Examiner stated "it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the templates taught by Gonzales to produce" various aspects of the present invention "as taught by Clements '172, in light of the teachings of Scocca, *in order to easily allow a user to specify, preview, and remotely produce the storybook document in volume*". Office Action at p.6, para. 6 (emphasis added).

For combining Schubert with Gonzales, Scocca, and Clements, the Examiner stated "it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have added" aspects of the present invention "to the title page template of

Gonzales, as taught by Schubert, further in light of the teachings of Scocca and Clements '172, *in order to assist an amateur author in publishing a professional-looking storybook*". Office Action at p.7, para. 7 (emphasis added).

For combining Schach with Gonzales, Scocca, Clements, and Schubert, the Examiner stated "it would have been obvious to one of ordinary skill in the art, at the time the invention was made, for the kit to include aspects of the present invention "as taught by Schach, with a software program in a computer for publishing the book, as taught by Gonzales, in light of the teachings of Scocca, Clements '172, and Schubert, *in order to provide specialized, more durable paper to use for the cover of a story book*". Office Action at p.9, para. 12 (emphasis added).

Applicant respectfully asserts that Examiner has not provided any express reasons why one of ordinary skill in the art would have thought to combine the cited references *to develop Applicant's solution to the problems in the prior art as claimed herein*. For example, the purported reasons to combine, do not explain why one of ordinary skill in the art at the time of the invention would have a reason to combine this group of WYSIWYG-type disclosures to create, *inter alia*, an invention that inputs minimal information in two "blank story book screens" which results in "automatically generating" at least "a cover page," "a title page" (that is printed on a first leaf's back-side and a second leaf's front-side), "a first story page," and "a second story page" "for printing in diametric contraposition".

Rather, the Examiner has provided mere conclusory statements that say A covers X and B covers Y, so it would have been obvious to combine A and B because one would want to provide X and Y. In other words, the broad conclusory statements that the Examiner provides as purported reasons to combine the references do not give reasons for how and why one of

ordinary skill in the art would read the references (at the time the invention was made) and develop Applicant's solutions to the problems in the prior art as claimed herein.

Second, the Examiner stated that the rationale for combining the references is that "one would want to combine improvements from Scocca, Clements, Schubert and Schach with the base invention of Gonzales in order to receive the well-known and expected benefits applicable to book publishing (e.g., proofing, preview, professional touches, hard covering)." Applicant respectfully submits that this rationale impermissibly incorporates hindsight reasoning as there is no language or teachings within the cited references to give any reasons to one of ordinary skill in the art to combine those references. Indeed, combination of the prior art references cited by the Examiner is further made difficult by Clements '172 teaching away and Gonzales disclosing non-analogous art.

"A prima facie case of obviousness can be rebutted if the applicant . . . can show 'that the art in any material respect taught away' from the claimed invention." *In re Geisler*, 116 F.3d 1465, 1469 (Fed. Cir. 1997). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, . . . would be led in a direction divergent from the path that was taken by the applicant." *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999). As mentioned above, Clements '172 teaches away from the present invention by disclosing a method for providing content on only one side of an insertion page (Clements '172 at 6:24-26). In contrast, aspects of the present invention automatically generates pages to print on both sides of a physical page. As a result, the fact that Clements '172 teaches away from the claimed invention rebuts the obviousness rejections and rationale for combining Clements '172 with the other prior art references.

Also, as illustrated above, Gonzales discloses a method for web publishing and not book publishing. Applicant's invention contemplates that users of the storytelling book publishing software to be, but not limited to, "students in a school" or those "in a home schooling environment". Gonzales, on the other hand, discloses a system directed towards departments in a company, and contains complex workflow with privileges, responsibilities and roles assigned to different types of users of the various elements of the invention disclosed in Gonzales (Gonzales at p.2, paras. 0033-0036). With all this complexity, a student would find it difficult to use the system disclosed in Gonzales. A system incorporating Gonzales would detract from the ease and simplicity of the present invention as required for an audience of students. As non-analogous art, one of ordinary skill in the art would have no reason to combine Gonzales with the other cited references.

For at least the reasons stated above, Applicant respectfully asserts that Examiner's rejections under 35 U.S.C. § 103 are in error and should be withdrawn.

III. Request for Reconsideration

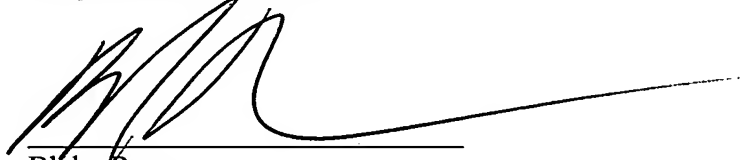
Applicant respectfully requests reconsideration of the present application in view of the aforementioned amendments and remarks. Although other features of the claims in the present application are also significant, Applicant respectfully submits that the pending claims are allowable for at least the aforementioned reasons. Accordingly, Applicant respectfully requests that the rejection under § 103 be withdrawn, and that the pending claims be allowed.

In the event that a telephone conference would advance examination of this application, the Examiner is invited to contact the undersigned at the number provided.

IV. Authorization

Applicant respectfully submits that no additional fees are due in connection with this paper except for a Notice of Appeal and Petition for Extension of Time. But, in the event the Commissioner determines that an additional extension of time or fee is due for this paper, the undersigned hereby petitions for any required extension of time and authorizes the Commissioner to charge any fee required to Milbank's deposit account no. 13-3250, order no. 02013-06034. A DUPLICATE COPY OF THIS PAGE IS ENCLOSED HEREWITH.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Blake Reese', written over a horizontal line.

Blake Reese
Reg. No.: 57,688

July 30, 2009

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